

REMARKS

I. Overview

These remarks are set forth in response to the Non-Final Office Action mailed September 24, 2007. As this amendment has been timely filed within the six-month statutory period, but in the first month subsequent to the three-month shortened statutory period, a one-month petition for extension of time and corresponding fee is filed herewith. Presently, claims 3 through 10, 19 through 23 and 29 through 32 are pending in the Patent Application, claims 1, 2, 11 through 18, 24 through 28 and 33 through 36 having been withdrawn in the Response to the Restriction Requirement filed July 18, 2007. Claims 3, 19 and 29 are independent in nature. In the Non-Final Office Action, however, each of claims 1 through 10, 19 through 23 and 29 through 36 have been rejected under 35 U.S.C. § 101. In response, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 101 and presume that the Examiner erred in rejection claims 1 through 3 and 33 through 36.

II. The Applicant's Invention

In order to reduce the time required to make multiple selections in a voice portal menu, the Applicants' invention provides a method and system for rearranging a voice portal menu, such that the usability of the voice portal is optimized. The first way in which the menu is optimized is to "flatten" the hierarchy of the menu. Rather than arranging a menu in multiple layers, the menu can be re-arranged to includes nodes in as small a number of layers as is practicable. As the number of times a user is prompted to

make a selection decreases, the overall interaction with the voice portal becomes faster, and the menu itself becomes more efficient and optimized.

In operation, Applicants' invention starts the process of flattening a hierarchy by taking all terminal nodes in a menu and rearranging them into a single layer, second menu. The user is then immediately presented with a new menu which only has the final choices in the directory. Consequently, the need to navigate through a range of non-terminal nodes before arriving at the final selection is eliminated.

In addition to flattening the hierarchy of the menu, to further optimize usability, Applicants' invention provides for a new menu to be arranged such that a user is presented with menu options that more quickly satisfy a user's desired final choice. Instead of navigating through an excessive number of selections or non-terminal nodes in the menu, the user is presented with a menu that has the minimum number of nodes necessary to present the user with a menu option that a user would tend to choose.

III. Rejections Under 35 U.S.C. § 101

On page 2 of the Non-Final Office Action, the Examiner asserted that the claimed invention, as recited in claims 3 through 10, 19 through 23 and 29 through 32 are directed to non-statutory subject matter. This rejection is respectfully traversed. In *State Street Bank and Trust Company v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed Cir. 1998), the court set forth the criteria for establishing statutory subject matter under 35 U.S.C. § 101 as follows:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to—process, machine, manufacture, or composition of matter—but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. *See In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994). For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a "useful, concrete, and tangible result." *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557. This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss.

Thus, as articulated above, the test for determining whether subject matter is patentable under 35 U.S.C. § 101 involves deciding if the subject matter produces a "useful, concrete, and tangible result."

A discussion of the procedural considerations regarding a rejection based upon lack of utility (i.e., 35 U.S.C. § 101) is found in M.P.E.P. § 2107.02. Specifically, M.P.E.P. § 2107.02(I) states that:

regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112

In paragraph [0023] of Applicants' published Patent Application, it is stated that in the invention as claimed in claims 3, 19 and 29,

To reduce the time required to make such multiple selections, the present invention provides a method and system for rearranging the menu...such that the usability of the voice portal is optimized.

The Applicant, therefore, has asserted a credible utility. As noted in M.P.E.P. § 2107.02(III)(A), the Court of Customs and Patent Appeals in *In re Langer* stated the following:

As a matter of Patent Office practice, **a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of § 101** for the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope. (emphasis in original)

Since a credible utility is contained in Applicants' specification and expressed clearly and expressly in claims 3, 19 and 29, the utility requirement of 35 U.S.C. § 101 (i.e., whether the invention produces a useful, concrete, and tangible result) has been met.

Of note, in the informative opinion of the Honorable Board in Ex Parte Bilski, Appeal No. 2002-2257 (March 8, 2006), the Honorable Board observed

For now, we interpret the State Street and AT&T test to be a test for when transformation of data by a machine is statutory subject matter. The test could be clarified by the facts of the cases: (1) transformation of data (i.e., electrical signals representing data) is by a machine; (2) the data corresponds to something in the "real world"; and (3) no physical acts need to occur outside of the machine (internal transformation of electrical signals by the machine is sufficient)...Where the steps define a transformation of physical subject matter (tangible or intangible) to a different state or thing, as normally present in chemical, electrical, and mechanical cases, there is no question that the subject matter is statutory.

Applying the views of the Honorable Board to Applicants' invention as claimed, a transformation of data by a machine occurs in the flattening of a hierarchy of nodes that corresponds to a voice portal menu--something in the "real world". Further, no physical acts need occur outside of the machine. **Of note, the transformation of a menu in a voice portal is a transformation of physical subject matter to a different state or thing.** Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claims 3 through 10, 19 through 23 and 29 through 32 under 35 U.S.C. § 101.

IV. Conclusion

The Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. § 101 owing to the foregoing remarks. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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